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United States  
Circuit Court of Appeals,  
FOR THE NINTH CIRCUIT.

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Union Tool Company,	} <i>Appellant,</i>
<i>vs.</i>	
Elihu C. Wilson,	} <i>Appellee.</i>

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Appellee's Answer to Petition for Rehearing.

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RAYMOND IVES BLAKESLEE,  
*Solicitor for Appellee.*

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Union Tool Company,

*Appellant,*

*vs.*

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## **Appellee's Answer to Petition for Rehearing.**

Before taking up the consideration of the several points urged by the appellant in its petition for rehearing, we desire to direct the serious attention of this court to the fact that several of the references contained in said petition are grievously misquoted. We would be glad to believe that this is accidental and merely due to the haste with which the petition was doubtless prepared, but the fact that in the companion case, No. 2996, Your Honors were obliged to return the opposing counsel's (Mr. Lyon's) briefs for correction before they could be considered, points strongly to the suspicion that these errors are not accidental.

As an instance we will point to page 32 of the petition in which the citation from page 513 of the record is quoted. Besides other errors the last three lines are made to read as follows:

“We have attempted to dodge the election made in this case.”

This statement is again quoted in italics on pages 36 and 37, so there can be no doubt that opposing counsel make vigorous use of the sentence in the form they give it.

Now, if Your Honors will refer to the record as cited by opposing counsel, and right where they themselves obtained this sentence, you will find that it reads as follows:

“We have *NOT* attempted to dodge the election made in this case, nor do we intend that the defendant shall dodge the further questions of infringement presented in and by Complainant’s Exhibit Reamer Type ‘F,’ and for that reason we have filed the further bill mentioned.” [Record pp. 513 and 514.]

It is difficult to believe that opposing counsel would fail to carefully compare a quotation upon which they build several pages of argument. It is also difficult to believe that accidental errors in quotations in this petition should always distort the import of the statement in question in favor of the opposing counsels’ case. This was true of numerous similar instances in the briefs in the case No. 2996 above referred to.

The quotation on page 33 of the petition is entirely different from the original statement to be found on page 438 of the record. The quotation should be pre-

ceded by asterisks in order to show that it begins at the middle of a sentence with, in this instance, an important qualifying phrase omitted. Also the quotation is divided into two sentences by a period where no such sense is given to it in the original.

These misquotations and the long argument that was adduced, by opposing counsel, from the new sentence they had created, were used to show that Your Honors had “fallen into a misapprehension as to the issues raised by the pleadings in the case A-4-B-62.”

Again the opposing counsel predicate a long argument on the construction to be given to claims 9 and 19 on pages 25 and 26 of the petition and misquote said claims so as to seriously distort their meaning. In the third line of the quoted claims at the bottom of page 25 it will be found to read “On the inner FORKS of the prongs” instead of “On the inner FACES of the prongs.”

Claim 19 is misquoted on page 26 of the petition in line 3 and following. It is made to read “And THE bearing-face” instead of “And A bearing-face.” This error, together with the addition and omission of commas to wrongly set off the modifying phrases, makes it possible to derive an entirely erroneous understanding of the meaning of the claim.

Judge Cushman’s statements on pages 11 and 14 will be found to be misquoted, and the statement from the opinion of this court in case No. 2996, quoted on page 9 of the petition, is wrongly punctuated and misquoted. While the mistakes in these last three quotations do not seem to be such as would materially affect

their meaning, they are, nevertheless, inexcusable and seem to be intended to give the impression that the other misquotations, upon which arguments are built, are also accidental.

However, the most flagrant instance of misrepresentation in this petition is one which cannot be accidental. We refer to the pretended illustration of the Double improved body or mandrel opposite page 12. At the time we received this petition we called the attention of opposing counsel and the court to the fact that this drawing was deceptive and did not represent the elements of the underreamer it purported to illustrate. At the same time this misrepresentation was called to the attention of Your Honors through His Honor, Judge Hunt, in chambers, and instructions were then given, by him, to opposing counsel, to correct this drawing before the petition was submitted. *This has not been done.*

In this illustration of petitioner the true size of the lug element of this improved reamer is misrepresented. The illustrations of Types "D" and "E" on the same page are photographs of the respective reamers placed in such a position as will plainly show this lug element, which has been formed by shearing away the web or side of the original Double device so as to form the lug elements, or at least, by adding the lug elements. But the illustration of the Double improved body is made up so as to conceal the form and size of this lug element, which is identical with that plainly illustrated in the Types "D" and "E" of the petition. The only difference in these bodies is that the "Improved Type"







has the web sheared away so as to form an acute angle with the lug element while this is a right angle in the Types "D" and "E." In both instances the object was to make room for and provide bearings for the shoulders of the cutter-head when Double abandoned his "slips" and made a cutter with a shank and a broad cutter-head which this court has held to be an invention of Wilson.

We challenge the opposing counsel to show why they did not illustrate the "Double Improved Body" by photograph, as they did the Wilson body on the same page. Such a photograph would be easily obtained in view of the statement in this petition that they have made 4,900 underreamers of this type. (Page 7.) Yet instead of such a photograph, which would faithfully represent the actual machine, they choose to submit this incorrect drawing. In order that this device may be properly represented in this argument, we are including in this reply an actual photograph of the Double improved underreamer body. In order to show its convincing resemblance to the Double Type "D" we have had it photographed in the same position opposing counsel have used in their illustration of said Type "D." Your Honors will note that the Double improved body, which is the subject of this photograph and which was selected at random, has been used in underreaming. The photograph plainly shows, not only that broad cutter-heads were used with this body, but the wear of these broad cutter-heads will be seen to extend almost the full width of the lug elements. We have, therefore, in the Double improved device,

the broad cutter-head and shanked cutter and the extreme width of bearing of said cutter-head on the lug element of the reamer body. *These infringed features are the substance of the Wilson invention, as has been found by this court.*

In addition, we likewise include a true photographic reproduction of the cuts on page 19 of the catalogue of appellant, which truly discloses the "Double Improved" reamer. This clearly shows the patented Wilson lug element at the lower end of the reamer body which serves as a spreading bearing for the cutters, which cutters, as seen, are provided with the broad cutter-head having lateral shoulders to co-act with said lug element, said cutters also having the shanks which were novel with Wilson. Why wasn't appellant honest enough to place before Your Honors this true picture of the "Double Improved" reamer, which it had on hand in its own catalogue, instead of producing a deceptive picture?

Also whether they used a photograph or a drawing to illustrate the Double improved reamer, why did they not show this type of underreamer in the same position as they illustrated Types "D" and "E"? *The reason is perfectly obvious.* According to their statement, on page 7 of the petition, they made only a few of the reamers of the Types "D" and "E" but they are threatened by a serious measure of damages and accounting for profits because of the extensive infringement of the Wilson underreamer by this "Double Improved" type. This deceptive drawing of the "Improved Type" is intended to mislead Your Honors into

DOUBLE IMPROVED UNDER REAMER

PATENTED



U-164

Showing cutters collapsed ready for Pipe



U-165

Bottom View

Showing Massiveness in Construction

To set, screw eye bolt in key carrying mandrel; pull down until cutters collapse below the end of spreading bar, then place setting ring on riders of cutters, which holds same in a collapsed position, after which the eye bolt is removed. Lower into pipe, taking ring off when ring comes to the first wrench square. After passing through the pipe the cutters automatically expand to working position.



U-166

Showing ease and simplicity of setting for entering pipe

DOUBLE IMPROVED UNDER REAMER



the idea that the "Double Improved" type did not embody these features of the Wilson invention which are admitted in the illustrations of Types "D" and "E."

We are not alarmed by these misrepresentations on the part of the opposing counsel, as we realize that the able opinion Your Honors have rendered in this case is most convincing that you have studied the machines themselves, which are among the exhibits in this case, and are thoroughly acquainted with their construction and operation. We do, however, resent opposing counsels' methods, which we have found it necessary to point out to Your Honors on a former occasion, and with which we have been confronted throughout this litigation. We trust this petition for rehearing will be returned for correction before it becomes a part of the record in this case.

We do not believe that this court wishes us to reply in detail to the points mentioned in the petition for rehearing. The petition is intended to raise a discussion on all the issues in this case and all of which Your Honors have disposed of after mature consideration. We will impose upon the time and patience of this court to refer to only a few of the statements in said petition.

On pages 4 and 5 of the petition the foundation of a large portion of the argument for a rehearing is laid by statements intended to convey the impression that Wilson's underreamer was only an improvement on the original type of Double device, but "the resultant mode of operation was in part the same or the mechanical equivalent of Double's reamer." These

questions have been fully discussed and disposed of in the companion case, No. 2996, recently decided by this court.

The petition contains long arguments intended to show that Double invented an underreamer body and that Wilson took that body and added “prongs” or “forks” to it. As a corollary the petitioner argues that Double should be permitted to take the body he invented and add “lugs” to it. Here is an example of using words only instead of referring to the things themselves and learning what they are in the light of what they do and the operations they perform.

Reference to the exhibits in this case will show that when a Double underreamer body has lugs added to it, it is no longer a Double underreamer body but a Wilson underreamer body, because these lugs are intended to, and they are essential to, adapting that reamer body to a cutter with a shank and a broad cutter-head. These are the invention of Wilson and are features of his underreamer. An underreamer cannot be successful without them and Double and his Union Tool Company, the appellant, appropriated these features from the Wilson invention because the public would accept no substitute therefor.

These features are covered fully by *combination* claims 9 and 19 of the patent in suit (Wilson underreamer) and we do not believe it necessary to take up the detailed discussion of this matter contained in the petition. The petitioner-appellant admits that these features of claims 9 and 19 are present in the infringing devices in the following words:

“On the opposite page are photographs respectively disclosing Types D, E and ‘Double Improved,’ held to infringe claims 9 and 19. *With the exception of the so-called lug elements, formed at the lower ends of the respective bodies of said underreamers by shearing away the side web of the extension,* said underreamers, so far as concerns any elements of said claims 9 and 19, are substantially identical with the underreamer body and extension disclosed in figure III of the prior Double patent, No. 748,054.” (Page 13.)

Again on page 23:

“By a mere glance at said Types D, E and ‘Double Improved’ it is apparent that not one of said types embodies a single advantage inherent in the Wilson combinations of claims 9 and 19, *other than that inherent in the lugs projecting at the lower end of the body to hold the cutters apart.*” (The italics are ours.)

The petitioner does not state that these same features are included in the Type “F” underreamer which he intimates was so different from the “Improved” and Types “D” and “E” that only the former should have been held to have infringed the Wilson patent. If this were so, is it not strange that this difference was not indicated by a photograph of the Type “F” reamer in this petition when the appellant resorts to a drawing which is specially constructed in order to disguise in the “Improved” reamer the features he is willing to show in the Types “D” and “E”? The facts will be plain to Your Honors on inspection of the exhibits in this case. The features of the Wilson inven-

tion, which are essential to a satisfactory underreamer, will be found in every Double design of an underreamer made since the original Double device was driven from the field and rendered obsolete by the Wilson underreamer. Is it not convincing that while Double has been making all these imitations of the Wilson reamer, that the Wilson reamer is the same today as it was when first conceived by Wilson? It was the final step in the art and Wilson took that step.

On page 19 of the petition will be found a statement of some of the other advantages of this Wilson device which the petitioner claims he has not yet been able to incorporate into his infringements except in Type F. It is not essential to sustain a charge of infringement that the infringer make the identical machine. Most valuable patents could be evaded by omitting some essential feature of the device imitated, if this were the rule. Your Honors have truly said in the opinion in this case:

“The fact that the appellant has not used each attribute of the Wilson invention can not excuse it from being held to infringement.”

The appellant admits in his petition, in the citations above quoted, that he uses the lug elements of the Wilson invention. These are so important in an underreamer, permitting as they do the use of the Wilson cutters with shanks and broad heads, which in turn eliminated nearly all the evils of the earlier devices, that we cannot conceive of their use without including with them the train of elements and mode of operation which they were designed to permit of and perform.



A study of these infringing devices of the appellant will show that every one of them does use these features which comprise the substance of the Wilson invention. In fact, it could not have obtained these advantages acquired by its infringement had it not used such train of elements and mode of operation.

The appellant calls attention to the decision of this court wherein it was declared that the Wilson underreamer was not an infringement of the *original Double device*, and argues that, because the original Double device was not the same as the Wilson underreamer, therefore the other types of Double devices do not infringe the Wilson underreamer patent. This argument will be found on page 39 and following of the petition, and is too illogical to deserve further comment.

On page 39 of the petition is the following statement:

“The Double reamers, Types ‘D,’ ‘E’ and ‘Double Improved,’ have identically the same principle and the same mode of operation as the Double reamer thus referred to by this court.” (Meaning the original Double device.)

If this is true it remains for the appellant to explain why it does not revert to the manufacture of the long discredited and obsolete original Double underreamer.

The broad Wilson combination claims found infringed herein are, as to the lug elements, not limited to any inclination or angularity of their bearing faces; and the mode of operation including the holding apart of the cutters by co-engagement of their lateral shoulders with these lug elements is not dependent upon any

particular inclination or augularity. Differences in specific mode of expansion and collapsion, existing between the Wilson and Double reamers, cannot, therefore, avoid a finding of infringement.

The latter portion of the petition is a long discussion of the consolidation of the cases A-4 and B-62. This has been passed upon several times, and finally by Your Honors. We feel that it is unnecessary to re-argue this matter here. We are fully in accord with the decision rendered by this court in this matter and, as a reply to the argument in this regard in the petition of appellant, we will only refer this court especially to the treatment of this matter by Frederick S. Duncan, Esq., of the New York bar, and which is printed in full at pages 238 to 258, inclusive, of appellee's opening brief in the case at bar.

We have faithfully examined this petition for rehearing and we find in it nothing that has not been fully argued before, and considered, by this court. It merely raises for discussion the merits of the whole case, and surely the appellant cannot claim that ample opportunity has not been afforded it to place all its facts and points before this court at the proper time. As a reply to any other points we will merely refer this court to our former briefs which, we are confident, made our case clear to Your Honors.

Respectfully submitted,

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*Solicitor for Appellee.*